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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,566	12/05/2003	Tae-Ahn Jahng	559552000100	8922
25225 7590 02/04/2008 MORRISON & FOERSTER LLP 12531 HIGH BLUFF DRIVE SUITE 100 SAN DIEGO, CA 92130-2040			EXAMINER HOFFMAN, MARY C	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 02/04/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/728,566	JAHNG, TAE-AHN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Mary Hoffman	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2007.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 39-42, 44-51 and 58-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39-42, 44-51 and 58-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/01/2007 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 39-42, 44-51 and 58-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended claim 39 to recite "substantially axially inelastic" in line 7 and line 16. Similarly, claim 41, line 2, claim 45, line 4, claim 46, line 5, claim 47, line 2, claim 51, line 3 now recite "substantially axially

inelastic." This is being considered new matter because it has been determined that the embodiments described (stainless steel, titanium, etc.) cannot be considered substantially axially inelastic since all metals exhibit some degree of elasticity, as described by the material property, Modulus of Elasticity. Since Applicant did not originally provide the definition of "substantially axially inelastic" in the disclosure, the addition of this terminology is being considered new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 39-42, 44-51 and 58-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Since there is no definition of "substantially axially inelastic member" in the disclosure, this terminology is being considered indefinite because it is an oxymoron.

"substantially...inelastic." It has been held that the term "substantially" is a broad term. *In re Nehrenberg*, 280 F 2d 161, 126 USPQ 383 (CCPA 1960). Thus, it is unclear if this limitation is claiming an inelastic member or an elastic member.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 39, 41-42, 44-51 and 58-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trieu et al. (U.S. Patent No. 2003/0195514).

Trieu et al. connection system for use in a bone fixation device, comprising a first bone coupling assembly (see FIGS. 19(a) and 209(a), ref. 510a) adapted to be secured to a first vertebrae; a rod comprising: a rigid first end portion (ref. 504(a)) including a surface received at least partially by and coupled to the first bone coupling assembly; a rigid second end portion (ref. 504(b)); a longitudinal flexible, substantially axially inelastic member (ref. 502) located between the first end portion and the second end portion, non-slidably fixably coupled to the first end portion, and non-slidably coupled to the second end portion; and a second bone coupling assembly coupled to the rod at a location other than the first end portion and adapted to be secured to a second vertebrae. The longitudinal flexible, substantially axially inelastic member comprises at least one of a metal wire comprising a plurality of metal yarns and a braided metal wire structure comprising a plurality of interwoven metal wires. The second bone coupling assembly is connected to the second end portion.

Trieu et al. disclose the claimed invention except for a rigid spacer located between the first and second ends portions and circumferentially disposed about the longitudinal flexible member; wherein the first and second end portions directly limit motion of the rigid spacer along the longitudinal member and the rigid spacer limits the minimum distance between the first vertebrae and the

second vertebrae; the spacer being a metal or a synthetic polymer, or a metal-synthetic hybrid; a second spacer; and the claimed diameters/sizes of the components.

Ferree discloses a rigid spacer ([0033], FIG. 10, ref. 1002) located between the first and second ends portions and circumferentially disposed about the longitudinal flexible member; wherein the first and second end portions directly limit motion of the rigid spacer along the longitudinal member and the rigid spacer limits the minimum distance between the first vertebrae and the second vertebrae; the spacer being a metal or a synthetic polymer to provide extension blocking.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the device of Trieu et al. a rigid spacer located between the first and second ends portions and circumferentially disposed about the longitudinal flexible member; wherein the first and second end portions directly limit motion of the rigid spacer along the longitudinal member and the rigid spacer limits the minimum distance between the first vertebrae and the second vertebrae; the spacer being a metal or a synthetic polymer in view of Ferree to provide extension blocking.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Trieu et al. in view of Ferree with metal-synthetic hybrid spacer since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

*In re Leshin*, 125 USPQ 416. It would have also been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Trieu et al. in view of Ferree having a plurality of spacers, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. It would have been an obvious matter of design choice to modify the device of Trieu et al. in view of Ferree to meet the claimed diameters/sizes of the components, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

### ***Response to Arguments***

Applicant's arguments filed 11/17/2007 have been fully considered but they are not persuasive.

Applicant argues that the disclosure supports the claim amendment, "substantially axially inelastic member." The examiner respectfully disagrees for the reasons set forth in the above rejections under 35 U.S.C. 112, first and second paragraphs.

Applicant's other arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

The above rejections are deemed proper.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCH

